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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,268	09/16/2003	Scott Gielt	L&P/1392	1445

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EXAMINER

OMGBA, ESSAMA

ART UNIT PAPER NUMBER

3726

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,268

Applicant(s)

GIETT ET AL.

Examiner

Essama Omgba

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,9,13,21,23 and 27 is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12,14-20,22,24-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 14-18 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Myers et al. (WO 97/44275).

With regards to claims 1, 15 and 19-31, Myers et al. discloses a machine for securing a border wire on a mattress inner spring, the machine comprising a support 12 for supporting the mattress inner spring 8 and border wire 6, a clip applicator 20, 22 for applying clips 9 to the mattress inner spring and the border wire to secure the border wire to the mattress inner spring, a movement generating system 18 for effecting relative movement between the mattress inner spring and border wire and the clip applicator such that the clip applicator successively secures the clips to the mattress inner spring and the border wire around a perimeter of the mattress inner spring, a clip applicator feed system 88 configured to receive and feed to the clip applicator a plurality of non-coiled strips of clips, and a controller 200 controlling activation and deactivation of the clip applicator, the movement generating system and the clip applicator feed system, see pages 5, lines 4-17, page 6, lines 29-34 and page 11, lines 16-31.

Applicant should note that the recitation the "machine being configured to be supplied with the clips in a collated strip which has not been stored in, nor is fed to said machine

Art Unit: 3726

from a roll" amounts to an intended use and as such has not been given any patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The examiner further submits that the machine of Myers et al. is capable of using clips in a collated strip which has not been stored in, nor is fed to the machine from a roll. There is no disclosure of structure that would define over the machine of Myers et al.

For claims 2, 3, 16 and 17, see page 6, lines 2-8 and figures 1 and 2.

For claims 4 and 18, see page 5, lines 17-26.

For claims 14 and 28, see page 7, lines 14-20.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 8, 10-12, 19, 20, 22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al.

With regards to claims 5 and 19, Myers et al. discloses a machine for securing a border wire on a mattress inner spring as shown above wherein the clip applicator feed system comprises a track 88 along which the clips travel, the track having a first feed end into which strips of clips are fed from a roll 86 and a second clip applicator end operably connected to the clip applicator for supplying the clips, see page 7, lines 36-37. Although Myers does not disclose an operator supplying the strips of clips, however it would have been obvious to one of ordinary skill in the art that automating the supply of clips provided a distinct advantage over manual supply.

For claims 6 and 20, Applicant should note that providing a tubular track is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in using a tubular track versus the one taught by Myers et al.

For claims 8 and 22, see page 8, lines 1-2 of Myers et al.

For claims 10-12 and 24-26, see page 8, lines 3-29 of Myers et al.

Allowable Subject Matter

5. Claims 7, 9, 13, 21 and 27 are allowed.

Response to Arguments

6. Applicant's arguments filed March 29, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Myers et al. machine is configured to be supplied clips in a collated strips which have been stored in rolls and which are fed

Art Unit: 3726

to the machine from the rolls as opposed to the machine of the present invention which is configured to be supplied with the clips in a collated strip which has not been stored in, nor fed to the machine from a roll, the examiner submits that such a recitation amounts to an intended use and as such has not been given any patentable weight as outlined above in the rejections. Furthermore the machine of Myers et al. is capable of using clips in a collated strip which has not been stored in, nor is fed to the machine from a roll. Applicant should recite structure that would define over the machine of Myers et al.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3726

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Essama Omgba
Primary Examiner
Art Unit 3726

eo
June 11, 2005